

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB NOV. 16, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Tiffany & Broadway, Inc.

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Serial No. 74/670,640

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Michael W. Smolar, president of Tiffany & Broadway, Inc.  
for Tiffany & Broadway, Inc.<sup>1</sup>

Julie Clinton Quinn, Trademark Examining Attorney, Law  
Office 109 (Deborah Cohn, Managing Attorney)

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Before Quinn, Hohein and Chapman, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Tiffany & Broadway, Inc. has filed an intent-to-use  
application to register the mark TIFFANY for "ladies' dress  
shoes."<sup>2</sup>

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<sup>1</sup> Applicant was represented by outside counsel throughout this case until after the filing of applicant's reply brief. At that time applicant filed a "power of attorney and revocation of prior powers" requesting that all correspondence now be sent to Michael W. Smolar, president, at applicant's address.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, if applied to its identified goods, would so resemble the following registered marks, all owned by the same entity, as to be likely to cause confusion, mistake or deception:

**TIFFANY**

**TIFFANY & CO.**

<sup>3</sup>

and

<sup>4</sup>

for "combs, and belts for supporting wearing-apparel";  
TIFFANY & CO. for "retail store services specializing in  
the sale of: jewelry; watches and clocks; stationery;  
chinaware; figurines; silver flatware, coffee services,  
bowls, trays, picture frames, and boxes; desk accessories;  
bar accessories; clothing accessories; baby gifts; smoker's  
accessories; crystal glasses, bowls, vases, jars,  
candlesticks, boxes, buckets, and baskets; precious and  
semi-precious stones; dies for engraving, stamping, or  
embossing stationery; flexible stainless measuring tapes;

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<sup>2</sup> Ser. No. 74/670,640, filed May 8, 1995. The application is based on applicant's bona fide intention to use the mark in commerce.

<sup>3</sup> Reg. No. 136,218, issued October 26, 1920, republished under Trademark Act of 1946, third renewal.

thermometers; barometers; medals and medallions; metal plates from which book plates are stricken off; non-electric lamps; candelabra; playing cards; sewing kits; ironstone dinnerware; earthenware boxes and baskets; and ashtrays"<sup>5</sup>; and TIFFANY & CO. for "clothing, namely, men's ties."<sup>6</sup>

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont<sup>7</sup> factors.

Turning first to a consideration of the respective marks, applicant does not dispute that the involved marks are similar "in sound, appearance, meaning and connotation." (Applicant's brief, p. 4). It is clear that the involved marks are essentially identical.

Turning to a consideration of the respective goods and services, applicant essentially contends that when its specific goods, "ladies' dress shoes," are compared to

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<sup>4</sup> Reg. No. 136,219, issued October 26, 1920, republished under Trademark Act of 1946, third renewal.

<sup>5</sup> Reg. No. 1,251,356, issued September 13, 1983, Section 8 affidavit accepted, Section 15 affidavit received.

<sup>6</sup> Reg. No. 1,723,904, issued October 13, 1992, Section 8 affidavit accepted, Section 15 affidavit received. Registrant disclaimed the terms "& Co.".

<sup>7</sup> See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

men's ties, to belts, and to retail store services, specializing in the sale of, inter alia, clothing accessories, there will be no confusion as to source of the goods and services. Specifically, applicant asserts that as to "men's ties" and "belts for supporting wearing-apparel", neither applicant nor the registrant sell sufficient amounts of clothing that the purchasing public would relate either parties' marks with clothing; that retail store services (even those selling clothing accessories) are not related to ladies' dress shoes, especially because the registrant does not sell shoes; and that there is no complimentary or conjoint use of applicant's "ladies' dress shoes" with any of the cited goods or services. Applicant also contends that registrant owns a registration in which the identification of goods lists, inter alia, "clothing accessories, namely, money clips, cufflinks, key holders, collar clips, collar pins, collar stays; tiebars; tie tacks; tie slides; belt buckles and studs,"<sup>8</sup> thereby establishing that shoes are not a clothing accessory.

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<sup>8</sup> Reg. No. 1,283,306, issued June 26, 1984, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The Examining Attorney objected to applicant's reference to this registration as untimely filed with the appeal brief, and that it was not a proper copy of the registration. The Examining Attorney's objection is not well taken because on June 24, 1996, applicant

In support of her position as to the relatedness of the respective goods and services, the Examining Attorney has made of record copies of pages from four catalogs showing that belts are "purchased to go with shoes" (Examining Attorney's final Office action dated September 4, 1996, p. 3). In addition, the Examining Attorney submitted several third-party registrations, each of which issued on the basis of use in commerce, to demonstrate the close relationship between shoes and belts, and between shoes and ties, by showing that a single entity has adopted a single mark for both shoes and belts, and for both men's ties and women's shoes.

Third-party registrations, however, are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

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submitted a copy of Reg. No. 1,283,306 as part of applicant's response to the Examining Attorney's second Office action.

Moreover, it is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992).

Based on the record before us, we readily conclude that applicant's goods, "ladies' dress shoes," are closely related to the cited registrant's "men's ties" and "belts for supporting wearing-apparel", as well as its retail store services specializing in the sale of clothing accessories, which we deem to include belts.

Regarding the respective trade channels and purchasers, applicant argues that its goods are purchased by women who will be the users of the shoes (Applicant's brief, pp. 7 and 18); and that men's ties and ladies' dress shoes "are sold in different smaller-sized clothing stores and are sold in different locations in larger-sized clothing stores and in department stores" (Applicant's brief, pp. 5 and 18). Both of these arguments are

unsupported by any evidence. Even if the items were sold in different boutique-type stores, or in different areas of large department stores, the record shows that shoes and belts are often coordinated, and thus, may be purchased together in a single shopping excursion. Therefore, the parties' respective goods could be offered and sold to the same class of purchasers in the same stores.<sup>9</sup>

Finally, turning to the fame of the cited marks, applicant concedes that the marks, TIFFANY and TIFFANY & CO., are "well-known", but contends that this fame is limited to the areas of "crystal, jewelry, luxury and gift items" (Applicant's brief, p. 6); and specifically, that the cited registrant is not famous as a manufacturer or seller of clothing. The Examining Attorney submitted evidence in the nature of numerous Lexis/Nexis excerpts referring to the "famous" and/or "world famous" Tiffany & Co. to establish that the cited marks are famous, and entitled to a broad scope of protection.<sup>10</sup>

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<sup>9</sup> Applicant noted in its brief (page 14) the prices of certain of the cited registrant's goods. The Examining Attorney objected to applicant's evidence of the prices of certain goods sold by the registrant on the basis that the evidence was untimely, having been introduced for the first time in applicant's brief. The Examining Attorney's objection is well taken, and we have not considered this evidence. Even if we had considered the evidence, we would not reach a different result in this case.

<sup>10</sup> The Examining Attorney also cited the following three cases wherein the fame of the mark TIFFANY was judicially recognized in the circumstances of those cases: Tiffany & Co. v. Classic Motor

The Court of Appeals for the Federal Circuit addressed the issue of fame in the case of Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), stating as follows:

Achieving fame for a mark in the marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders."

Even if we limit the registrant's fame to those areas for which applicant concedes such fame (jewelry, crystal, luxury and gift items), women knowing of the fame of TIFFANY, upon seeing TIFFANY on ladies' dress shoes, may well assume some connection or association with the cited registrant.

Any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to

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Carriages Inc., 10 USPQ2d 1835 (TTAB 1989) (wherein CLASSIC TIFFANY - in stylized lettering - for automobiles was found confusingly similar to TIFFANY and TIFFANY & CO. for jewelry, household items, glassware, lamps, and many other products); Tiffany and Company v. National Gypsum Company, 459 F.2d 527, 173 USPQ 793 (CCPA 1972) (wherein the Court reversed the Board's dismissal of the opposition against the mark TIFFANY for wood-fiber, low density ceiling tile and ceiling grid panels); and Tiffany & Co. v. Tiffany Tile Corporation, 345 F.2d 214, 145 USPQ 483 (CCPA 1965) (wherein the Court reversed the Board's dismissal

do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, at 1440 (TTAB 1993).

Applicant cited several cases during the ex-parte prosecution and appeal of this case. We have carefully considered those cases. In particular, we will address the case of *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984), which is distinguishable from the case now before the Board. In the British Bulldog case the involved mark, PLAYERS, had different connotations for shoes (connoting outdoor activities) and men's underwear (connoting indoor activities); and there was no argument regarding any fame of the cited mark.

Based on the identity of the marks, the relationship of the parties' respective goods and services, the identity of the trade channels, and the fame of the cited registrant's marks, we find that there is a likelihood that the purchasing public would be confused if applicant were to use TIFFANY as a mark for ladies' dress shoes.

Decision: The refusal under Section 2(d) is affirmed.

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of the opposition against the mark TIFFANY TILE for ceramic tile).

**Ser. No.** 74/670640

T. J. Quinn

G. D. Hohein

B. A. Chapman  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board